

REMARKS

I. Introduction

Claims 12, 13 and 15-22 are currently pending in the present application after cancellation of claim 14. Reconsideration is requested in view of the following remarks.

II. Rejection of Claims 12-14 and 22 under 35 U.S.C. § 102

Claims 12-14 and 22 have been rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent Application No. 2002/0008440 (“Hedenetz”).¹ Claim 14 has been canceled. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

To anticipate a claim under 35 U.S.C. §102(b), a single prior art reference must identically disclose each and every claim feature. See Lindeman Maschinenfabrik v. American Hoist and Derrick, 730 F.2d 1452, 1458 (Fed. Cir. 1984). If any claim feature is absent from a prior art reference, it cannot anticipate the claim. See Rowe v. Dror, 112 F.3d 473, 478 (Fed. Cir. 1997). Furthermore, in order to rely on the doctrine of inherent disclosure for the anticipation rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int'l. 1990)). “Inherency, however, may not be established by probabilities or possibilities,” i.e., “mere possibility that a certain thing may result from a give set of circumstance is not sufficient.” In re Robertson, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999).

In support of the anticipation rejection, the Examiner contends that Hedenetz discloses the feature that “if a certain variable is present, blocking at least one of the voltage detection and a relaying of the detected voltage value.” In this regard, the Examiner does not provide any citation for this assertion, and even after a careful reading of the Hedenetz

¹ The Examiner states that the claims are “anticipated by Hedenetz et al. (US 6016231),” but Hedenetz is Pub. No. U.S. 2002/0008440 A1.

reference, it is not at all apparent exactly what section of Hedenetz the Examiner is relying on. However, in order to expedite the prosecution of the present application, Applicants have amended claims 12 and 22 to clarify the present invention. Amended claim 12 recites, in relevant parts, a “method for controlling a piezoelectric actuator for injection of fuel supplied by a fuel supply rail, comprising: performing a voltage detection at a specified time of a voltage applied to the piezoelectric actuator . . . ; and selectively blocking at least one of the voltage detection and a relaying of the detected voltage value, depending on a detected fuel pressure in the fuel supply rail.” Amended claim 22 recites substantially similar features as the above-recited features of claim 12. Applicants note that there is no disclosure in Hedenetz regarding “selectively blocking at least one of the voltage detection and a relaying of the detected voltage value, depending on a detected fuel pressure in the fuel supply rail.” To the extent the Examiner states that “the abstract of Hedenetz discloses sensing the voltage across the device at a predetermined time in synchronization with a fuel injection event of the piezoelectric element,” this observation has no relevance to the claimed limitation in which the “blocking at least one of the voltage detection and a relaying of the detected voltage value” is dependent on “a detected fuel pressure in the fuel supply rail.” In any case, there is no disclosure in Hedenetz that can enable the above-recited claimed limitation.

For at least the foregoing reasons, there is no reasonable basis to sustain the anticipation rejection of claim 12, claim 13 (which depends on claim 12), and claim 22.

III. Rejection of Claims 15-21 under 35 U.S.C. § 103(a)

Claims 15-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Application 2002/0008440 A1 (“Hedenetz”) in view of Examiner’s belief. Applicants respectfully submit that the rejection should be withdrawn for at least the following reasons.

In rejecting a claim under 35 U.S.C. § 103(a), the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. In re Rijckaert, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, the Examiner must show, *inter alia*, that there is some suggestion or motivation, either in the

references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references, and that, when so modified or combined, the prior art teaches or suggests *all of the claim limitations*. M.P.E.P. §2143. In addition, as clearly indicated by the Supreme Court, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to [modify] the [prior art] elements” in the manner claimed. See KSR Int’l Co. v. Teleflex, Inc., 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Id., at 1396. To the extent that the Examiner may be relying on the doctrine of inherent disclosure in support of the obviousness rejection, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; see also Ex parte Levy, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)).

In support of the obviousness rejection, the Examiner only addresses the limitations of claims 15-17, and the Examiner does not even mention the features recited in claims 18-21. In particular, the features recited in claims 20 (“in the event of blocking, the last non-blocked voltage value is used for at least one of a closed-loop control and monitoring”) and 21 (“in the event of blocking, the last manipulated variable used prior to blocking is used for open-loop control”) are completely unrelated to the features of claims 15-17 mentioned by the Examiner. Since the Examiner has not even mentioned the features recited in the rejected claims 18-21, there is no way the Examiner has satisfied the basic requirement for obviousness stipulated by the Supreme Court, i.e., “some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” For at least this fundamental reason, the obviousness rejection of claims 18-21 cannot be sustained, as a matter of law.

Independent of the above, to the extent the Examiner simply repeats the conclusory statement that “the Examiner considers that one with ordinary skill in the art would recognize at least one of the claimed functions to be necessary to compensate for the aging of the piezoelectric actuator,” not only does this assertion completely violate the Supreme Court’s

stipulation that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness,” but the Examiner’s assertion is completely unsupported. Should the examiner insist on maintaining this asserted opinion, the Examiner should provide some documentary reference that supports the Examiner’s contention.

Independent of the above, to the extent the Examiner cites paragraphs [0044], [[0052] and [0084] of Hedenetz, the Examiner does not even state exactly how these cited paragraphs suggest the actual claimed limitations, let alone which limitations. In any case, claims 15-21 ultimately depend on claim 12. As explained above, the overall teaching of Hedenetz does not suggest all of the features of parent claim 12. Furthermore, the Examiner’s conclusory statement clearly does not remedy the deficiencies of Hedenetz as applied against parent claim 12. In addition, dependent claims 15-19 recite that the “selective blocking” of “at least one of the voltage detection and a relaying of the detected voltage value” is dependent on further time variables in addition to “a detected fuel pressure in the fuel supply rail” recited in parent claim 12, and there is simply no suggestion in Hedenetz any “selective blocking” of “at least one of the voltage detection and a relaying of the detected voltage value” is dependent the combination of the detected fuel pressure and further time variables. Furthermore, with respect to claims 20 and 21, there is not a shred of suggestion in Hedenetz that the features recited in claims 20 (“the last non-blocked voltage value is used for at least one of a closed-loop control and monitoring”) and 21 (“the last manipulated variable used prior to blocking is used for open-loop control”) are to be performed “in the event of the blocking” which is dependent “**on a detected fuel pressure in the fuel supply rail,**” as recited in parent claim 12. Therefore, dependent claims 15-21 are not rendered obvious by Hedenetz.

For at least the foregoing reasons, withdrawal of the obviousness rejection of claims 15-21 is requested.

CONCLUSION

In light of the foregoing, Applicants respectfully submit that all of the pending claims 12, 13 and 15-22 are in condition for allowance. Prompt reconsideration and allowance of the present application are therefore earnestly solicited.

Respectfully submitted,

KENYON & KENYON LLP



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By: SONG LEE for Gerard Messina
Gerard A. Messina (Reg. No. 35,952)
One Broadway
New York, New York 10004
(212) 425-7200

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